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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK ROLAND BOEDER

Appeal 2009-003289
Application 10/782,794
Technology Center 1600

Decided: September 25, 2009

Before TONI R. SCHEINER, ERIC GRIMES, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving a plant patent application. The Examiner has rejected the claim as anticipated by a foreign publication which was shown to be enabled by a foreign sale of the claimed plant. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

The Specification describes a chrysanthemum plant named “Cetwotone Pink” (Spec. 1). The claim on appeal reads as follows:

1. A new and distinct variety of chrysanthemum plant as described and illustrated.

As evidence of unpatentability, the Examiner relies on the following:

UPOVROM Plant Variety Database for European Plant Breeder’s Right, application number 011850 for chrysanthemum plant named “Cetwotone Pink” (Feb. 15, 2002).

Royal Horticultural Society Dictionary of Gardening, Vol. 1, pp. 614-618 (1992).

M. Z. Karim et al., “Rapid Multiplication of *Chrysanthemum morifolium* through *in vitro* culture,” 5 Pakistan Journal of Biological Sciences 1170-1172 (2002).

EconPort, “Dutch Auction,” http://www.econport.org:8080/econport/request?page=man_auctions-dutchauction, retrieved Aug. 22, 2005.

Chrysanthemum Breeders Assoc., Sales, <http://www.cba-nv.nl/index.cfm?act=Agenten.default>, retrieved Aug. 22, 2005.

ANTICIPATION

Issue

The Examiner has rejected the claim under 35 U.S.C. § 102(b)

as being anticipated by the European Plant Breeder’s Right (PBR) application number 011850 published on February 15, 2002, more than one year prior to the filing date of the instant application in view of Applicant’s admission that the instant cultivar was first sold in August 2002 at a flower auction in the Netherlands (reply dated January 24, 2005) and the Royal Horticultural Society Dictionary of Gardening 1992, vol. 1 (RHS) describing how to asexually propagate a chrysanthemum plant.

(Ans. 3-4.)

The Examiner cites EconPort as evidence that the “sale of the plant was not a single solitary occurrence and one of ordinary skill in the art would have been able to obtain the plant” (*id.* at 4). The Examiner concludes that “this rejection meets the criteria set out by *In re Elsner* [381 F.3d 1125 (Fed. Cir. 2004)] that the sale [was not] an isolated occurrence and that one of ordinary skill would have known how to propagate the instant plant” (*id.* at 5).

Appellant contends that the *Elsner* court remanded the application involved there to the PTO for further fact-finding related to the accessibility of the foreign sales, and that the “relevant accessibility under §102(b) should be accessible in the United States” (Appeal Br. 8). Appellant contends that the rejection should be reversed because “there is no evidence on this record that sales in the Netherlands any time more than one year before the filing date of the present application in fact resulted in, or could have resulted in, *possession in the United States of plant material* ‘to practice asexual reproduction of the plant’ as claimed herein” (*id.*, underlining omitted).

The issue with respect to this rejection is: Has Appellant shown that the Examiner erred in finding that, according to the controlling case law, the evidence of record shows that the claimed plant was anticipated by a foreign publication and foreign sale?

Findings of Fact

1. The application on appeal was filed February 23, 2004.

2. The chrysanthemum denominated “CETWOTONE PINK” was disclosed February 15, 2002 in the UPOVROM Plant Variety Database for European Plant Breeder’s Right, application number 011850.

3. “[T]he first sale of ‘Cetwotone Pink’ to the public took place in the Netherlands in August 2002, when flowers were offered at the Flower Auction. The trade designation of this variety is ‘Twotone Pink.’” (Appellant’s Response filed Jan. 24, 2005, page 3.)

4. “‘Cetwotone Pink’ is usually grown as a cut mum. Flowering stems, including flowers and foliage in this product group, are sold at the Dutch auction” (Appellant’s response filed June 2, 2005, page 2).

5. “[S]ale has occurred regularly in the Netherlands under the commercial name ‘Twotone Pink’” (*id.*).

6. In 2002, Dutch flower auctions sold 3.4 billion in cut flowers and potted plants; that year, the Aalsmeer Flower Auction alone had more than 1.5 billion in sales, 1,375 buyers and 6,734 sellers (EconPort at 1).

7. “Outdoor-flowering chrysanthemums are invariably propagated from softwood basal growths in late winter or early spring” (Royal Horticultural Society Dictionary of Gardening 614, left col.).

8. The Royal Horticultural Society Dictionary of Gardening provides detailed guidance on asexually reproducing chrysanthemums via cuttings (*id.*).

Principles of Law

“A person shall be entitled to a patent unless – . . . (b) the invention was patented or described in a printed publication in this or a foreign country

or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b).

“[B]efore any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *In re LeGrice*, 301 F.2d 929, 936 (CCPA 1962).

A rejection under 35 U.S.C. § 102(b) based on a single prior art reference can rely on additional references as evidence that a method of making the claimed subject matter would have been known to persons of ordinary skill in the art. *See In re Samour*, 571 F.2d 559, 562-63 (CCPA 1978).

“[E]vidence of the foreign sale of a claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing that plant, thereby creating a § 102(b) bar.” *In re Elsner*, 381 F.3d 1125, 1128 (Fed. Cir. 2004).

When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar.

Id. at 1129.

For a foreign sale to enable the printed publication, the “foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art.” *Id.*

at 1131. In addition, the evidence must show that the foreign sale “enabled one of ordinary skill in the art to reproduce the claimed plant without undue experimentation.” *Id.*

Analysis

The claimed plant was identified in an application for European Plant Breeder’s Right (PBR) on February 15, 2002 (FF 2). The claimed plant was first sold to the public in August 2002 (FF 3). Both the publication and the sale occurred more than one year before the filing date in the United States of the present application (FF 1).

The Examiner has provided evidence that a sale of flowers at the Dutch flower auction is not an isolated or solitary event that would go unnoticed by those of ordinary skill in the art (FF 6). The Examiner has also provided evidence that those of ordinary skill in the art knew how to asexually reproduce chrysanthemums (FF 7, FF 8).

The facts of this case thus show a publication identifying the plant and a foreign sale that put those skilled in the art in possession of the plant, permitting its asexual reproduction without undue experimentation. Under the standard set out in *In re Elsner*, therefore, the sale combines with the publication to erect a statutory bar to patentability.

Appellant argues that the foreign publication itself was not enabling (Appeal Br. 3) and that the foreign sale does not qualify as prior art under any part of 35 U.S.C. § 102 (*id.* at 4). Both of these arguments were made and answered in *Elsner*, see 381 F.3d at 1128 and 1129-30, and therefore cannot form the basis for a different outcome here.

Appellant also argues that the holding in *Elsner* conflicts with the precedent set in *In re LeGrice*, 301 F.2d 929 (CCPA 1962) (Appeal Br. 7) and that “the Federal Circuit in *Elsner*] erroneously treated §161 plant patent applications differently from patent applications claiming other subject matter” (*id.* at 9).

The *Elsner* court, however, concluded that its holding was not in conflict with *LeGrice*. See 381 F.3d at 1130 (*LeGrice* “did not address the manner in which a publication may be enabled, and it did not decide whether other evidence such as the availability of an invention through foreign sales may be considered in determining whether a printed publication enables a skilled artisan to reproduce a claimed plant”). Therefore, *Elsner* is controlling law on the issue on appeal.

Finally, Appellant points out that the court in *Elsner* remanded the application to the USPTO for further fact-finding relating to the accessibility of the foreign sales, and argues that the “relevant accessibility under §102(b) should be accessible in the United States” (Appeal Br. 8, emphasis omitted). Appellant argues that there is no evidence in the record to show that the foreign sales of the claimed plant resulted in possession of the plant in the United States (*id.*) and that such possession would not have been possible because plant material entering the United States is subject to a six-month quarantine (*id.* at 4-5).

This argument is also unpersuasive. Section 102(b) bars patentability for an invention described in a foreign publication more than a year before the patent application was filed. The courts have held that a document must be accessible to the interested public in order to be considered a

“publication” under § 102(b). See *In re Bayer*, 568 F.2d 1357, 1361 (CCPA 1978) (“[A] printed document may qualify as a ‘publication’ under 35 U.S.C. § 102(b), notwithstanding that accessibility thereto is restricted to a ‘part of the public,’ so long as accessibility is sufficient ‘to raise a presumption that the public concerned with the art would know of [the invention].’” (citation omitted, alteration in original)); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988) (“The statutory phrase ‘printed publication’ has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was ‘published.’”).

The courts have also held that a publication bars patentability if a person of ordinary skill in the art can combine the written description of the invention with their own knowledge of the field and (in this case) asexually reproduce the plant described in the publication. See *LeGrice*, 301 F.2d at 936.

Importantly, however, none of the cases cited above that interpret the text of § 102(b) held that a claimed invention must be possessed or practiced *in the United States* in order for the statutory bar of § 102(b) to apply. Appellant has pointed us to no other cases holding that § 102(b) requires accessibility in the United States.

In re Elsner does not support Appellant’s position. The *Elsner* court directed the USPTO to determine whether the foreign sale of the plant at issue in that case was “an obscure, solitary occurrence that would go

unnoticed by those skilled in the art.” *Elsner*, 381 F.3d at 1131. The court, however, did not state or imply that the foreign sales would not be considered enabling if the plant could not have been possessed in the United States prior to the critical date.

The *Elsner* court did not, for example, direct the USPTO to determine if the foreign sale put the plant in the possession of a skilled worker in the United States. Nor did the court state or imply that the scope of the inquiry into accessibility should be limited to buyers in the United States. Rather, the court held that the claimed plant’s “availability must have been known in the art, just as a printed publication must be publicly available.” *Id.* As discussed above, the cases addressing availability of printed publications do not hold that availability in the United States is the test of whether a printed publication is “publicly available.”

Conclusion of Law

Appellant has not shown that the Examiner erred in finding that, according to the controlling case law, the evidence of record shows that the claimed plant was anticipated by a foreign publication and foreign sale.

SUMMARY

We affirm the rejection of claim 1 as anticipated by PBR 011850 with evidence of enablement provided by the admitted public sale of the claimed variety in August 2002 and the disclosure by the Royal Horticultural Society of Gardening that chrysanthemums were commonly reproduced asexually at the time of the prior art publication.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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